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| 09/617,590 | 07/18/2000 | Sha Ye | PORTP007 | 8637 |
| 26541 | 7590 | 11/16/2004 | EXAMINER | |
| RITTER, LANG & KAPLAN 12930 SARATOGA AE. SUITE D1 SARATOGA, CA 95070 | | | JASMIN, LYNDIA C | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3627 | |

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/617,590

Applicant(s)

YE ET AL.

Examiner

Lynda Jasmin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 7-44 is/are rejected.
- 7) ☒ Claim(s) 5 and 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Amendment received August 24, 2004 has been acknowledged.

Claim Rejections - 35 USC § 101

2. Claims 1 and 7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case, claim 1 only recites an abstract idea. The recited steps of merely obtaining information about a customer and an insurance policy and performing a mathematical analysis to determine the best insurance policy does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to select an insurance policy over another.

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As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In the present case, none of the recited steps are directed to anything in the technological arts as explained above with the exception of the recitation in the preamble that the method is "computerized". Looking at the claim as a whole, nothing in the body of the claim recites any structure or functionality to suggest that a computer performs the recited steps. Therefore, the preamble is taken to merely recite a field of use.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces rating billing event (i.e., repeatable) used in determining usage information for an account (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1 and 7 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4, 7-13, 16-22 and 25-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Hanagan et al. (2001/0056362 A1).

As best understood, Hanagan et al. a computer implemented method and system embodied in a computer readable medium for rating a billing event in a real time accounting system with the steps of receiving a billing event for an account (via customer billing manager 18), retrieving current usage information for the account (event rater and pricer ERP 16), and rating the billing event upon receiving the event, according to the billing event, the current usage information, and a usage dependent rating scheme (as disclosed in box 0079).

Hanagan et al. further discloses a volume discount scheme comprises one or more rate step points (via price plans associated a number of discount per call) and two or more tiers (for example, there can be one tax rate for voice and another for fax), the event having an associated event quantity (via combining charges from multiple customers for accounts for volume discounts), and determining one or more rates applying to the event (based on volume), calculating a cost of the event and updating the account (box 0214). Hanagan et al. further discloses updating the account with the billing event (via customer billing manager CBM 18), providing a cost of the event to a source of the event (via cost tracking such as internal billing, invoicing and reporting) on a web page (via since user can view documents online), and calculating the cost is

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performed during the rating or after the rating is performed (via the event rater and pricer).

Hanagan et al. further discloses exactly one rate applies to the event (via single tier per service), wherein rating the event includes determining the exactly one rate responsive to the current accumulated usage information and calculating a cost of the event (box 0214). Further, the one or more rate step points are responsive to a number of events (such as number of phone calls made) during a period (box 0216). The rate step points are responsive to an amount of usage (volume such as duration) of a resource associated with the event wherein the duration is minutes of a phone call (via connect time). The amount of usage may further be a number of items purchased (box 0082). Hanagan et al. further discloses that a cost of the event is determined responsive to a sum of the current accumulated usage information and the event quantity (box 0196). Further, a table is used in determining the cost (residential customer object and corporate customer object).

Hanagan et al. further discloses performing a look-forward into a rating scheme responsive to the account information comprising current accumulated usage information (via creating 156 recurring charge events in advance of a bill run to speed up the processing of billing) and sending marketing information to a user associated the account responsive to performing the look-forward (via helping in responding to customer inquiries which includes invoices, statements, marketing literature, and shipments). Hanagan et al. further discloses volume discount scheme including a plurality of rating curves (via the pricing structure object 66), including selecting one or

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more of the plurality of rating curves responsive to information about the event (box 0108).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 14, 15, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanagan et al.

Although Hanagan et al. does not explicitly disclose sending an email message to user, or the number of events is a number of content items (news articles or quotes) viewed, however, Hanagan et al. discloses a billing event that is related to all type of telecommunication services including electronic transaction such as wireless. Thus, one of ordinary skill in the art at the time the invention was made to have provided communicating by sending email message and viewing an online content since such is well used in wireless telecommunication services, and the Examiner takes Official Notice as such.

Allowable Subject Matter

7. Claims 5 and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter: the prior art made of record fails to disclose if the event quantity is less than a tier reservoir, adjusting an account balance responsive to a current tier and the event quantity and if the event quantity is not less than the tier reservoir performing: calculating a portion cost for a portion of the event quantity equal to the current tier reservoir, adjusting an account balance by the portion cost, adjusting the remaining event quantity by the current tier reservoir; incrementing the current tier, setting the current tier reservoir to be a distance to a next step point from the incremented current tier, repeating said steps of calculating, adjusting the account balance, adjusting the remaining event quantity, incrementing and setting until the event quantity is less than the tier reservoir, then performing: calculating a final portion cost of the remaining event quantity responsive to the current tier, and adjusting the account balance by the final portion cost.

Response to Arguments

9. Applicant's arguments filed August 24, 2004 have been fully considered but they are not persuasive.

Applicants argue that "Hanagan describes near-real time message processing, where message are received in batches (§ 0079)... near real time systems do not rate billing events when they are received as claimed." The Examiner notes that Hanagan further discloses in § 0083 that the invention is a Customer Care and Billing (CCB) solution, providing convergent and modular functionality, *real-time information*, drastically shortened time to market, and a flexible architecture. And further in § 0196, Hanagan discloses Event Rater and Pricer 16 component of ERP 16 provides convergent *real time message processing functionality* for a provider's usage and non-usage events based on concepts for handling very large volumes of data.

Applicants further argue that Hanagan does not support a prima facie case of anticipation of disclosing "rating a billing event upon receiving the billing event according to the billing event, the current usage information, and a usage dependent rating scheme" as recited in claim 1. The Examiner respectfully disagrees. Applicants are reminded that during examination, claims are given their "broadest reasonable interpretation" *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969).¹ Furthermore, "[a]bsent an express definition in their specification, the fact that applicants can point to definitions or usages that conform to their interpretation does not make the PTO's definition unreasonable when the PTO can point to other sources that support its interpretation." *Morris*, 127 F.3d at 1056, 44 USPQ2d at 1029.

¹ See also MPEP §2111; *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc).

Under the broadest reasonable interpretation standard noted above, the Examiner maintains her interpretations. However, to the extent that the Examiner's definitions are either different from or in dispute with Applicant's definitions (and unless the Examiner expressly noted otherwise), the Examiner hereby adopts the following definition as the broadest reasonable interpretation and ordinary and accustoms meaning in all her claim interpretations:

Near "1. To, at, or within a short distance or interval in space or time." *The American Heritage® Dictionary of the English Language, Third Edition* copyright © 1992 by Houghton Mifflin Company.

Current "1. a. Belonging to the present time: *current events; current leaders*. b. Being in progress now: *current negotiations*. 2. Passing from one to another; circulating: *current bills and coins*." *The American Heritage® Dictionary of the English Language, Third Edition* copyright © 1992 by Houghton Mifflin Company.

Therefore, it is the Examiner's position that Hanagan discloses the claimed invention where:

"the ERP (Event Rater and Pricer) 16 component of ERP 16 provides convergent real time message processing functionality for a provider's usage and non-usage events based on concepts for handling very large volumes of data. ERP 16 accepts and processes network and non-network events to produce bill-ready events (a billable event record that has been completely rated, summarized, processed, discounted and taxed) that can be processed by CBM (Customer Billing Manager) 18. ERP 16 actively collects raw events from different network elements 28 and also processes input from other external entities and other subsystems of the Customer Care and Billing system. The collected events are formatted, validated, assembled and checked for duplicates. After the events are rated and summarized, they are stored in the Billable Event database. ERP 16 also processes recurring and non-recurring charges, performs taxing, and performs final pricing of the events, for example, volume discounting. The billable events in the database are

accessible for billing and can also be retrieved by CCM (Customer Care Manager) 12 and other systems to answer customer queries."


Further Applicants did not seasonably traverse the well-known (Official Notice) statement(s) as stated in the previous Office Action (Paper Dated February 17, 2004, ¶ no. 7), therefore, the object of the well-known (Official Notice) statement(s) are taken to be admitted prior art. See MPEP §2144.03.

Applicant's argument having been found unpersuasive, the prior art rejection has not been withdrawn.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda Jasmin whose telephone number is (703) 305-0465. The examiner can normally be reached on Monday- Friday (8:00-5:30) alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Lynda Jasmin
Primary Examiner
Art Unit 3627
11/12/04